

REMARKS

Applicant has carefully reviewed the Application in light of the Office Action mailed September 29, 2006. At the time of the Office Action, Claims 1-2 and 4-29 were pending in the Application. Applicant respectfully requests reconsideration of the pending claims and favorable action in this case.

Section 103 Rejection

The Examiner rejects Claims 1, 2, 4, 7, 9-11, 14, 16-18, 21, 23-25, 27 and 29 under 35 U.S.C. §103(a) as being unpatentable over U.S. Publication No. 2004/0028060 issued to *Kang* (hereinafter "*Kang*") in view of U.S. Patent No. 6,085,976 issued to *Sehr* (hereinafter "*Sehr*"). The Examiner rejects Claims 5-6, 8, 12-13, 15, 19-20, 22, 26 and 28 under 35 U.S.C. §103(a) as being unpatentable over *Kang* and *Sehr* in further view of U.S. Publication No. 2003/0067924 issued to *Choe et al.* (hereinafter "*Choe*"). These rejections are respectfully traversed for the following reasons.

It is respectfully submitted that Claim 1 is patentable over the art of record based on at least the third criterion of obviousness: none of the references alone or in combination teach, suggest, or disclose each and every claim limitation. For example, Independent Claim 1, as previously amended, recites: "a network element operable to receive a packet and to identify a sequence number included in the packet, wherein the sequence number is associated with a state of one or more adjacent network elements, and wherein the network element is operable to exchange incremental state information with the one or more adjacent network elements if the sequence number included in the packet has not already been received."

The network element's operability to exchange incremental state information is now specifically recited in Independent Claim 1 and yet there is nothing in any of reference for these teachings. The network element's operability to exchange incremental state information allows for exchanging incremental state information with one or more adjacent network elements. In effect, the sequence number can be included in the packet and it indicates the particular incremental state information to exchange. Specifically, these elements are circumscribed by Independent Claim 1.

Additionally, there is no recitation of exchanging incremental state information between a network element with one or more adjacent network elements by utilizing the sequence number included in the packet. The Examiner readily concedes this point in the Office Action, but argues that it would have been obvious to do so based on *Sehr*. Applicant respectfully disagrees because *Sehr* does not appear to apply any network element operable to receive a packet: much less utilizing a sequence number associated with the state of one or more network elements: much less one that exchanges incremental state information with one or more network elements.

Thus, because of the deficiencies of *Sehr* and *Kang* and, more specifically, because there is no disclosure of a network element's operability to exchange incremental state information of Independent Claim 1, the Examiner has failed to meet his burden imposed by the third criterion of obviousness.

Applicant also wishes to note that even if these elements of Independent Claim 1 were disclosed in the cited references, which they are not, the proposed *Sehr-Kang* combination is still improper because the Examiner has not shown the required suggestion or motivation in *Sehr* or *Kang*, or in the knowledge generally available to one of ordinary skill in the art at the time of the invention to combine these references. The mere fact that references *can* be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.¹ Thus, the mere fact that the teachings of one reference would improve the teachings of another reference, as the Examiner asserts, does not provide the required suggestion to combine. The U.S. Court of Appeals for the Federal Circuit has held that the fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggests the desirability of the modification.² Nothing in *Sehr* or in *Kang* suggests or motivates the proposed combination, nor has the Examiner provided evidence that suggests or motivates the proposed combination.³ Speculation in hindsight that "it would have been obvious" to make the proposed combination because the proposed combination would be

¹ M.P.E.P. § 2143.01 (emphasis in original).

² *In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992).

³ If "common knowledge" or "well known" art is being relied on to combine the references, Applicants respectfully request that a reference be provided in support of this position pursuant to M.P.E.P. § 2144.03. If personal knowledge is being relied on to supply the required motivation or suggestion to combine, Applicants respectfully request that an affidavit supporting such facts be provided pursuant to M.P.E.P. § 2144.03.

helpful is insufficient under the M.P.E.P.⁴ and governing Federal Circuit case law.⁵ The M.P.E.P. also confirms that this approach is improper and, thus, it should not be used here.⁶

Thus, obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination.⁷ The factual inquiry whether to combine references must be thorough and searching.⁸ This factual question cannot be resolved on subjective belief and unknown authority;⁹ it must be based on objective evidence of record.¹⁰

Furthermore, the Examiner is precluded from modifying the combined teachings of *Sehr* and *Kang* in an effort to teach the limitations of the pending claims because there is no indication in any of the references as to the desirability of making such modifications. The cited references must disclose the desirability of making the proposed modification.¹¹ The fact that the modification is possible or even advantageous is not enough.¹² A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.¹³

⁴ See M.P.E.P. § 2145 X.C. ("The Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references.").

⁵ For example, in *In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999), the Federal Circuit reversed a finding of obviousness by the Board of Patent Appeals and Interferences, explaining that evidence of a suggestion, teaching, or motivation to combine is essential to avoid impermissible hindsight reconstruction of an applicant's invention:

Our case law makes clear that the best defense against the subtle but powerful attraction of hindsight obviousness analysis is *rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references*. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.

175 F.3d at 999 (quoting *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1983)) (emphasis added) (citations omitted). See also *In Re Jones*, 958 F.2d 347 ("Conspicuously missing from this record is any evidence, other than the PTO's speculation (if that can be called evidence) that one of ordinary skill in the herbicidal art would have been motivated to make the modification of the prior art salts necessary to arrive at [the claimed invention].").

⁶ See M.P.E.P. §2145.

⁷ See *Carella v. Starlight Archery and Pro Line Co.*, 804 F.2d 135, 140, 231 USPQ 644, 647 (Fed. Cir. 1986).

⁸ See *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 USPQ 2d 1001, 1008 (Fed. Cir. 2001).

⁹ See *In re Lee*, 277 F.3d 1338, 1343-44, 61 USPQ 2d 1430, 1434 (Fed. Cir. 2002).

¹⁰ *Id.* at 1343, 61 USPQ 2d at 1434.

¹¹ *In re Mills*, 916 F.2d 680, 682 (Fed. Cir. 1990).

¹² See *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984).

¹³ *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). (See also M.P.E.P. §2141.02).

With respect to the second criterion of non-obviousness, the Examiner has also failed to show a reasonable expectation of success for the proposed combinations. The proposed combination (presumptively) attempts to combine divergent subject matter that has not been shown to be capable of operating according to any degree of predictability. The Examiner, without resorting to improper hindsight to look through the claimed invention, has not addressed the chance that the proposed *Sehr-Kang* combination would have any success whatsoever: let alone a reasonable expectation of success as is required. Therefore, Applicant respectfully submits that the Examiner has failed to establish the second criteria for a prima facie case of obviousness.

Assuming, for the sake of argument, that *Sehr* and *Kang* are analogous art, and that there is the required suggestion or motivation to combine *Kang* with *Sehr*, the proposed *Kang-Sehr* combination would fail because the limitations specifically recited in the pending claims are not disclosed in each of the references, as evaluated extensively above. Accordingly, such an argument is flawed in that it does not satisfy the third criterion of obviousness, as identified in the analysis above.

Independent Claims 9, 16, and 23 recite limitations similar, but not identical, to those recited in Independent Claim 1. Therefore, these claims are also allowable, for example, for the same reasons as identified above. Additionally, the corresponding dependent claims from these Independent Claims are also patentably distinct for analogous reasons.

Accordingly, all of the pending claims have been shown to be allowable as they are patentable over the references of record. Notice to this effect is respectfully requested in the form of a full allowance of these claims.

CONCLUSION

Applicant has now made an earnest attempt to place this case in condition for immediate allowance. For the foregoing reasons and for all other reasons clear and apparent, Applicant respectfully requests reconsideration and allowance of the pending claims.

Applicant believes no fee is due. However, if this is not the case, the Commissioner is hereby authorized to charge any amount required or credit any overpayment to Deposit Account No. 02-0384 of BAKER BOTTS L.L.P.

If there are matters that can be discussed by telephone to advance prosecution of this application, Applicant invites the Examiner to contact Thomas J. Frame at 214.953.6675.

Respectfully submitted,

BAKER BOTTS L.L.P.
Attorneys for Applicant


Thomas J. Frame
Reg. No. 47,232

Date: December 22, 2006

Customer No. **05073**